

REMARKS

In the Office Action, the Examiner rejected pending claims 1, 3–8, 10–15, and 17–32 under 35 U.S.C. § 103(a). The Examiner rejected claims 1, 3, 6–8, 10, 13–15, 17, 20, and 22–24 under § 103(a) as unpatentable over U.S. Patent 6,167,388 (“Ray”)¹ in view of Applicants’ disclosure. And the Examiner rejected claims 4, 5, 11, 12, 18, 19, 21, and 25–32 under § 103(a) as unpatentable over U.S. Patent 5,570,291 (“Dudle”)² in view of Applicants’ disclosure.

Information Disclosure Statement

On October 15, 2004 Applicants submitted a Form PTO 1449 along with a timely filed Information Disclosure Statement identifying references for consideration by the Examiner. Although the October 28, 2004 Office Action included a returned Form PTO 1449 submitted on March 8, 2002, the Office Action did not include the October 15, 2004 Form PTO 1449. Applicants request that the next communication from the Office include a copy of the Form PTO 1449 previously provided with an indication that the cited references have been considered.

Amendment

Applicants have amended claims 4, 11, 18, 19, 21, and 32 to more particularly claim Applicants’ invention. Claims 1, 3–8, 10–15, and 17–32 are currently pending.

¹ The Detailed Action only refers to “Ray.” The Form PTO-892, provided with the Office Action identifies U.S. Patent 6,167,388, which Applicants believe corresponds to the Ray reference. If a different reference was intended, Applicants request correction.

² The Detailed Action only refers to “Dudle.” Applicants believe that this corresponds to U.S. Patent 5,570,291, identified on the Form PTO-892, provided with the May 4, 2004 Office Action. Applicants request correction if another reference was intended.

Rejection of claims under § 103(a)

To establish a *prima facie* case of obviousness under §103(a), each of three requirements must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine references or modify a reference. (MPEP § 2143 (8th ed. Rev. Feb. 2003).) Second, there must be a reasonable expectation of success. (*Id.*) Moreover, both of these requirements must “be found in the prior art, and not based on applicant’s disclosure.” (*Id.*) Third, the reference or references, taken alone or in combination, must disclose or suggest every element recited in the claims. (MPEP §2143.03.)

Rejection over Ray in view of Applicants’ disclosure

The Examiner rejected claims 1, 3, 6–8, 10, 13–15, 17, 20, and 22–24 under § 103(a) as unpatentable over Ray in view of Applicants’ disclosure. Applicants traverse the rejection of these claims.

Ray discloses a system for selecting heating equipment. The Examiner acknowledges that Ray fails to disclose or suggest “that the simulation relates to the performance of the semiconductor” (10/28/04 Office Action at 3). The Examiner alleges, however, that the Background of the Invention portion of the instant application compensates for Ray’s deficiency. According to the Examiner, the Background of the Invention in the instant application discloses that “simulation of performance of electronic equipment is old and well known, but costly to implement.” (*Id.*) In fact, the Background of the Invention merely includes a discussion of the “Related Art” (Application at 1) and nowhere teaches that “simulation of performance of electronic

equipment is old and well known,” as alleged by the Examiner. The Examiner further alleges, “It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system for the selection of heating equipment as taught by Ray to include the selection of electronic components by including in the database of heating performance data, simulation data on semiconductors as taught by Applicant in order to help users select electronic equipment.” (10/28/04 Office Action at 3.) Aside from a bald statement that “it would have been obvious,” the Examiner provides no motivation to modify Ray. There is no teaching that the Background of the Invention section qualifies as “prior art,” and the Background of the Invention specifically states, “preparing simulation tools that can be used for the evaluation also **consumes much time and involves a large cost.**” (Application at 2 (emphasis added).) Thus, the Background of the Art portion of the instant Application specifically teaches away from using simulation tools for evaluation.

Independent claim 1 recites, “simulating a condition for manufacturing the electronic product including at least performance before outputting information of the electronic product.” Independent claim 8 recites, “wherein the first device causes to simulate a condition for manufacturing the electronic product including at least performance after causing to extract the electronic product from the database, and provides the applicant with the condition for manufacturing the electronic product to prompt the applicant to answer if the condition for manufacturing the electronic product is satisfied or not.” And independent claim 15 recites, “a fourth program code recorded on the recording medium and configured to assign the computer system a command for simulating a condition for manufacturing the electronic product including at least

performance before outputting the information of the electronic product.” Each of these claim elements is not taught or disclosed in *Ray*, and Applicants’ disclosure teaches away from the Examiner’s proposed modification. In light of the above noted deficiencies of the Related Art, Applicants’ disclosure does not compensate for the deficiencies of *Ray*.

For at least the foregoing reasons, the Examiner has not presented a *prima facie* case for rejecting independent claims 1, 8, and 15. Thus, each of these claims are allowable over *Ray*, as are their respective dependent claims—claims 3, 6, 7, and 22, which depend from claim 1; claims 10, 13, 14, and 23, which depend from claim 8; and claims 17, 20, and 24, which depend from claim 15.

Rejection over *Dudle* in view of Applicants’ disclosure

The Examiner rejected claims 4, 5, 11, 12, 18, 19, 21, and 25–32 under § 103(a) as unpatentable over *Dudle* in view of Applicants’ disclosure. Applicants traverse the rejection of these claims.

As set forth more fully in Applicants’ August 4, 2004 Response, *Dudle* fails to teach or suggest simulating a condition for manufacturing. Independent claim 4 recites, “simulating a condition for manufacturing the electronic product including at least performance before outputting information of the electronic product.” Independent claim 11 recites, “wherein the first device causes to simulate a condition for manufacturing the electronic product including at least performance after causing to extract the electronic product from the database, and provides the applicant with the condition for manufacturing the electronic product to prompt the applicant to answer if the condition for manufacturing the electronic product is satisfied or not.” Independent claim 18

recites, "a fourth program code recorded on the recording medium and configured to assign the computer system a command for simulating a condition for manufacturing the electronic product including at least performance before outputting the information of the electronic product." And independent claim 21 recites, "wherein the first device causes to simulate a condition for manufacturing the electronic product including at least performance after causing to extract the electronic product from the database, and provides the applicant with the condition for manufacturing the electronic product to prompt the applicant to answer if the condition for manufacturing the electronic product is satisfied or not." Each of these claim elements is neither taught nor suggested by *Dudle*, nor does the Examiner assert that *Dudle* teaches or suggests any of these claim elements. Moreover, for the reasons given above with respect to claims 1, 8, and 15, which recite claim elements to those recited in claims 4, 11, 18, and 21 discussed above, Applicants' disclosure teaches away modifying *Dudle*, and the Examiner may not rely on the noted deficiencies of the Related Art from Applicants' disclosure to compensate for the deficiencies of *Dudle*.

Because *Dudle* in combination with Applicants' disclosure fails to present a *prima facie* basis for rejecting claims 4, 11, 18, and 21, these claims should be allowed. Further claims 5, 25, 26, and 30 (which depend from independent claim 4); claims 12, 27, 28, and 31 (which depend from independent claim 11); and claims 19, 29, and 32 (which depend from independent claim 18), should likewise be allowed at least because of their dependence from allowable independent claims.

In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

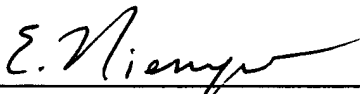
Customer No. 22,852
Application No.: 10/092,529
Attorney Docket No. 04329.2763-00

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit Account No. 06-0916.

Respectfully submitted,

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